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09/749,243	12/26/2000	Robert R. Holcomb	P00376US	5808

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/15/2002

*EB*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/749,243

Applicant(s)

HOLCOMB

Examiner

LOVERING

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on APR 24 16, 2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) 1 AND 2 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 3-24 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☒ Claim(s) 1-24 are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1 and 2, drawn to apparatus for generating an inorganic polymer electret, classified in Class 422, subclass 186.01.

II. Claims 3-24, drawn to inorganic polymer electret, classified in Class 516, subclass 111.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by a materially different apparatus such as that of Lewiner et al., 5,565,717.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required

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for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gregory C. Smith on April 8, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 3-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 2 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-7 and 17-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Winyall et al., 3,607,777, esp. Example 1 wherein the average particle size of the silica gel is 35 microns. The stated contents of Na<sub>2</sub>O and SO<sub>4</sub> would impart electric properties to the silica gel. As to claims 18-24 herein, the dried product would be about 100% silica gel.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 8-16 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to disclose which variable or variables of the process for generating an inorganic polymer electret are effective for producing a zeta potential between about 33 and 50 mV or narrower ranges therein. It would require more than routine experimentation on the part of one having ordinary skill in the art to determine said variable or variables and then to optimize them.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-24 are indefinite and inaccurate in reciting "electric" instead of --electret--.

8. Claims 8-16 are would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

9. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the inorganic polymer electrets of claims 8-16.

10. The disclosure is objected to because of the following informalities: The specification doesn't provide antecedent basis and support for the particle sizes, zeta potentials and polymer concentrations recited in the claims. Also, page 16, last line should recite --6a-- instead of "5a"; page 17 fails to mention Fig. 15b; page 22, line 7 should recite --inorganic-- instead of "organic"; and page 24, line 16, "15" should be changed to --15a, 15b--.

Appropriate correction is required.

11. The specification is objected to <sup>on pages 30-33 of 41</sup> for containing drawing Figs. 1-4 <sup>must contain prior art</sup> representing the prior art in the detailed description section. Illustrations showing the prior art must be so designated [MPEP § 608.02(g)] and placed in the drawing section of the application.

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12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

13. Applicant should insert the status of parent case 09/092,676 (now abandoned) on page 1 of the specification.

14. The remaining references listed on the attached Form PTO-1449 and Form PTO-892 are cumulative to the reference applied herein, and/or further show the state of the art.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc  
April 10, 2002

*Richard D. Lovering*  
RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP 1800/1700